

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Jorgen Beil
Serial No. : 09/918,074
Filed : July 30, 2001
For : FISH-LURING AROMATIC AND ENTICING ARTICLE BASED ON
POROUS, THERMOPLASTIC PLASTIC
Examiner : Hayes, Bret C.
Art Unit : 3644
Attorney
Docket No. : 534P008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

LETTER OF TRANSMITTAL

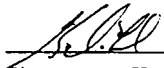
There are filed herewith (3) copies of Appellant's Brief on Appeal in the above-identified case.

The due date of Appellant's Brief was two months from the date of receipt (March 17, 2003) by the PTO Appellant's Notice of Appeal: namely May 17, 2003.


A check in the amount of \$320.00 in payment of the Brief on Appeal fee is enclosed herewith.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 14-0930.

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Signature: Kevin S. Lemack
Date: May 8, 2003

Respectfully submitted,



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-BRIEF ON APPEAL-

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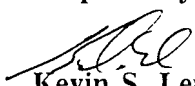

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Attorney
Docket No. : 534P008
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Sir:

APPEAL BRIEF

The Appellants hereby submit this brief, in triplicate, in support of the Appellants' appeal from the decision of the Examiner dated December 13, 2002 rejecting claims 1-18.

A check in the amount of \$320.00 for the fee for filing a brief in support of an appeal pursuant to 37 C.F.R. §1.17(f) is enclosed.

I. REAL PARTY IN INTEREST

As the assignee of the entire right, title and interest in the inventions and improvements which are the subject of this application, Daramic, Inc., having a place of business at 4838

Jenkins Avenue, North Charleston, South Carolina, is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

To the best of the Appellants' knowledge, no other appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-18 are pending in the subject application.

Claims 1-18 stand rejected.

IV. STATUS OF AMENDMENTS

An amendment to claim 17 was filed subsequent to the final rejection dated August 9, 2002. The finality of that action was withdrawn, and the amendment was entered.

V. SUMMARY OF INVENTION

Aromatic and/or enticing articles comprising a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance (page 3, lines 14-16), a method of luring fish (page 3, lines 17-18) by placing a porous, thermoplastic treated with at least one fish-luring aromatic and/or enticing substance in a body of water containing fish, and

a method for producing aromatic and/or enticing articles by treating a porous, thermoplastic material with at least one fish-luring aromatic and/or enticing substance. (p.3, lines 10-13).

VI. ISSUES

Whether claims 1-7, 13-17 and 18 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 4,957,787 to Reinhardt et al. in view of U.S. Patent No. 4,887,376 to Sibley et al. Whether claims 8-12 are unpatentable under 35 U.S.C. §103(a) over Reinhardt et al. in view of Sibley et al, further in view of U.S. Patent No. 3,351,495 to Larsen et al.

VII. GROUPING OF CLAIMS

The dependent claims stand or fall with the claims on which they depend.

VIII. ARGUMENTS

- A. The Appellants' claims are not obvious over Reinhardt et al. in view of Sibley et al.

The Examiner rejects claims 1-7 and 13-18 under 35 U.S.C. §103 as being unpatentable over Reinhardt et al. in view of Sibley et al. The Examiner states that Reinhardt et al. disclose an aromatic and/or enticing article comprising a porous, thermoplastic treated with at least one aromatic and/or enticing

substance. The Examiner admits that Reinhardt et al. do not disclose that the aromatic and/or enticing substance is fish-luring, and cites Sibley et al. for its disclosure of articles treated with fish-luring aromatic and/or enticing substances to attract fish. The Examiner concludes that it would have been obvious to modify the articles of Reinhardt et al. in view of Sibley et al. in order to treat articles with fish-luring aromatic and/or enticing substances.

Appellant respectfully disagrees.

1. The Reinhardt et al. reference is non-analogous

Reinhardt et al. disclose artificial flowers wherein the petals are made of linear ultrahigh molecular weight polyolefin and siliceous filler. Appellant respectfully submits that such flowers have absolutely no relation to fish lures, methods of producing fish lures, or methods of luring fish, and that therefore Reinhardt et al. concerns a non-analogous art. As a result, the combination of Reinhardt et al. is improper regardless of the teachings of the Sibley et al.

Specifically, the test articulated by the Federal Circuit to ascertain whether a reference is analogous in an obviousness determination is two tier:

- (1) determine whether the reference is within the field of the inventor's endeavor; and if not,

- (2) determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

In re Deminski, 230 U.S.P.Q. 313 (Fed. Cir. 1986). The Federal Circuit went on to say that the claimed invention and reference patents are within the same field of endeavor if they have essentially the same function and structure. In the instant case, the function of the Reinhardt et al. articles is as an artificial flower. The flower is formed of an artificial stem and at least one artificial petal of microporous material. The artificial petals may optionally contain perfume, a colorant, be printed to add background color, shading, highlights, veins, advertising text, graphics, etc. As such, the artificial flower is ornamental and functions to aesthetically enhance the environment in which it is placed. It does not function as a lure, and *a fortiori*, does not function as a fish lure. Indeed, it is not intended to be used in an aqueous environment.

Secondly, Reinhardt et al. is not pertinent to the particular problem with which the present inventor was involved, namely, finding and producing a suitable fish-luring enticing material that releases the fish-luring substances in an aqueous medium uniformly, is long-lasting, re-usable, and is inexpensive to manufacture. None of these issues is in any way relevant to the artificial flowers of Reinhardt et al.

Furthermore, the addition of perfume to the artificial flowers of Reinhardt is optional and there is nothing stated in

Reinhardt about controllably releasing the perfume if present. In addition, releasing perfume into the air is very different from dispensing an aromatic and/or enticing substance into water to attract fish.

The Examiner also relies on Appellant's submission of Hozumi et al. and Derrieu by way of an Information Disclosure Statement as indicative of the relevance of Reinhardt et al. However, Hozumi et al. was submitted because it was cited in an International Search Report and Derrieu was submitted because it was cited by the German Examiner. Accordingly, there is no admission on Appellant's part that these documents are in any way analogous. Moreover, and perhaps most importantly, Rule 97(h) (37 C.F.R. §1.97(h) states:

"(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b)."

Appellant respectfully submits that the Examiner's reference to the IDS is completely improper in this regard, and carries no weight as to whether Reinhardt is in fact non-analogous art.

Assuming for the sake of argument that the Examiner's reliance on the references cited in the IDS is proper, Appellants note that Hozumi et al. teach the use of an oil-absorbent polymer as a substrate for gradual release of fish-luring compositions (col. 1 lines 10-19), which clearly has more relevance than the optional inclusion of perfume in an artificial flower. Similarly, Derrieu discloses a device for enabling continuous and

complete controlled release of chemical substances from an insoluble polymer.

Accordingly, Appellant respectfully but vigorously submits that a person having ordinary skill in the art would not reasonably have expected to solve the problems facing the instant inventor by considering a reference dealing with artificial flowers. As stated in *Jurgens v. McKasy*, 18 U.S.P.Q.2d 1031, 1036 (Fed. Cir. 1991), if a cited reference "is not analogous art, it has no bearing on the obviousness of the patent claim".

2. Even if Reinhardt et al. is analogous, the references do not teach or suggest all the claim limitations, and there is no suggestion or motivation to modify Reinhardt et al.

To establish a prima facie case of obviousness, the prior art must teach or suggest all the limitations of a claim, there must exist a suggestion or motivation in the references themselves or as a matter of general knowledge to modify or combine the references, and there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). However, the Examiner may not establish obviousness using hindsight or in view of the teachings or suggestions of the Appellants. *Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 37 U.S.P.Q.2d 1237 (Fed. Cir. 1995). "To draw on hindsight knowledge of the...invention, when the prior art does not contain or suggest

that knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996). All limitations of a claim must be taught or suggested by the cited references to establish prima facie obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Even if Reinhardt et al. were analogous, Reinhardt et al. do not disclose how the perfume (column 1, lines 23) or the fragrance in Example 31 is released by the artificial petals. Accordingly, Reinhardt et al. do not in any way suggest that it is possible to treat the microporous material with fish-luring aromatic and/or enticing substances which then will be controllably released into water when the so-treated microporous material is immersed in water. The skilled artisan would find no motivation to modify Reinhardt et al. and apply it to the preparation of fish bait.

Indeed, it is rather common to treat all kinds of articles with perfume so as to provide a more attractive smell. Such treatment is particularly obvious with respect to flowers. However, Reinhardt et al. do not discuss the mechanism of adsorption and release of perfumes with respect to the specific microporous material used for making the artificial flowers. Accordingly, the skilled artisan would have no reason to believe that the Reinhardt et al. microporous material behaves

differently from any other materials when treated with perfume. Also notably absent from Reinhardt et al. is any teaching whatsoever about controlled release of the perfume optionally contained in the petals.

Sibley et al. is cited for its disclosure of treating articles with fish-luring aromatic and/or enticing substances to attract fish. Sibley et al. disclose a fish lure whose polymers contain an essence (fish attractant) and releases the attractant into water at an essentially controlled rate, usually for a period sufficient for the attracted fish to arrive at the lure. In its specific features, the invention of Sibley et al. comprises a polymer, preferably a hygroscopic polymer, that will allow an attractant to diffuse therefrom into water to establish an effective concentration of said attractant in the water for a controlled time (column 2, lines 31-35). According to Sibley et al. (column 2, lines 40-47), it is generally desirable to incorporate into the polymer the attractants prior to its being shaped. The attractants are usually added to the solution of the polymer, namely, after the cross-linking reaction, simply by mixing or stirring in the attractant or attractants. Sibley et al. disclose only crosslinked polymers. According to Sibley et al. at column 1, lines 56-60, it is undesired that baits are hydrophobic and do not get slippery in water, since this is thought to limit the efficacy of their textural context. Sibley et al. desire that the bait has the proper textural feel to it when the fish tests it. In order to obtain this proper textural

feel, the polymer materials according to Sibley et al. have the ability to absorb water to swell the polymer or render the surface hygroscopic rather than hydrophobic (column 2, line 67 to column 3, line 2). Specific polymers according to Sibley et al. are the hygroscopic, swellable, crosslinked acrylic materials (compare claim 1). Thus, Sibley et al. purposely teaches a specific polymer material to be used for fishing lures.

In contrast, the Reinhardt et al. flower petals are made of a microporous material comprising a matrix consisting of essentially linear ultrahigh molecular weight polyolefin, finely divided particular substantially water-insoluble siliceous filler distributed throughout the matrix, and a network of interconnecting pores communicating throughout the microporous material. This microporous material of Reinhardt et al. is very different from the crosslinked materials of Sibley et al., and the skilled artisan would have no reasonable expectation of success in incorporating the Sibley et al. fish attractant into the matrix of Reinhardt et al. Moreover, the skilled artisan would not be motivated to combine the teachings of Sibley et al. and Reinhardt et al. where the material of Reinhardt et al. does not fulfill the requirements of the specific material taught by Sibley et al.

Although the Examiner concludes that it would have been obvious to use the teaching of Sibley et al. to modify Reinhardt et al. in order to treat articles with fish-luring aromatic and/or enticing substances, the Examiner has provided no basis

for any suggestion or motivation in the cited references to so modify Reinhardt et al. See *In re Rouffet*, 47 U.S. P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."). No such showing has been made.

The present inventor was confronted with the problem of developing an inexpensive fish lure that effectively lures fish by uniformly releasing the fish enticing substance in a controlled manner. The present inventor found that the porous thermoplastic plastic material is suitable for both the uptake and release of fish-luring aromatic and/or enticing substances in a manner effective for attracting fish. A skilled artisan confronted with the same problem would not select the fish-luring substance of Sibley et al. and incorporate it into a flower petal. Indeed, there is nothing in Reinhardt et al. that would suggest to the skilled artisan that the flower could be immersed in water, and if so immersed, could release an aromatic substance in a manner effective for luring fish. There is not the slightest suggestion in the cited references that the Reinhardt

et al. (or Larsen) microporous material could be suitable to solve the problems confronting the present inventors.

B. The Appellants' claims 8-12 are not obvious over Reinhardt et al. in view of Sibley et al., and further in view of Larsen et al.

The arguments articulated above with respect to Reinhardt et al. and Sibley et al. are repeated herein by incorporation by reference.

Larsen et al. do not supply the deficiencies of the Reinhardt et al. and Sibley et al. references, nor do Larsen et al. in any way motivate the Reinhardt et al./Sibley et al. combination relied upon. Appellant also points out that the material used by Larsen has been used as battery separator material for decades, yet no one ever considered that such material would be useful as a base material for bait until the present invention.

In addition, the skilled artisan would not be motivated to modify the Reinhardt et al. material in view of Larsen, since there is absolutely no motivation to do so. The Examiner states that it would have been obvious to so modify Reinhardt et al. "in order to achieve the desired plastic material", but fails to articulate why the skilled artisan interested in creating an artificial flower would consult Larsen, which relates to a battery separator. Even if Larsen were consulted, there is no

standard-load melt index or reduced viscosity taught by Larsen in the artificial flower of Reinhardt et al., since there is no apparent advantage in doing so.

IX. CONCLUSION

For the reasons set forth above, the Appellant requests that the Examiner's rejection of claims 1-18 under 35 U.S.C. §103(a) be reversed and that all pending claims be allowed.

Respectfully submitted,



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APPENDIX

1. Method for producing aromatic and/or enticing articles and parts thereof, comprising treating a material comprising porous, thermoplastic plastic with at least one fish-luring aromatic and/or enticing substance.
2. Method according to claim 1, in which said material has an average pore size of less than 20 μm pore diameter.
3. Method according to claim 1, in which said material has an average pore size of less than 3 μm pore diameter.
4. Method according to claim 1, in which said material has an average pore size of less than 1.0 μm pore diameter.
5. Method according to claim 1 or 2, in which more than 50% of the pores of the material have a diameter of 0.5 μm or less.
6. Method according to claim 1 or 2, in which the void volume of the material is at least 50%.
7. Method according to claim 1 or 2, in which the plastic is selected from the group consisting of polyvinyl chloride and polyolefin.
8. Method according to claim 7, in which said material is comprised of 8 to 100 vol.% polyolefin with a molecular weight (weight average) of at least 300,000, a standard-load melt index of substantially 0, measured in accordance with ASTM-D-1278-57T (condition E), and a reduced viscosity of not less than 4.0, measured with a solution

- of 0.02g of the polyolefin in 100g of decalin at 130°C, 0 to 92 vol.% filler and 0 to 40 vol.% plasticizer.
9. Method according to claim 8, in which said material is comprised of 15 to 60 vol.% polyolefin, 35 to 80 vol.% filler and 1 to 7 vol.% plasticizer.
 10. Method according to claim 8, in which the polyolefin is ultra-high molecular weight polyethylene.
 11. Method according to claim 8, wherein said filler is finely-divided silica.
 12. Method according to claim 8, wherein said plasticizer is process oil.
 13. Method according to claim 1, further comprising adhering, welding, heat-shaping and/or printing said material before it is treated with said fish-luring aromatic and/or enticing substance.
 14. Aromatic and/or enticing articles, comprising a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance.
 15. The aromatic and/or enticing articles of claim 14, wherein said plastic has an average pore size of less than 20 μ m pore diameter.
 16. The aromatic and/or enticing articles of claim 14, wherein said plastic is selected from the group consisting of polyvinyl chloride and polyolefin.

17. The aromatic and/or enticing baits of claim 14, wherein said bait is in the form selected from the group consisting of fish-catching devices, feed baskets, buoyancy blocks for fish-catching nets, basic lead sheathings, blinker casings, spinner casings, twisters and parts thereof.
18. Method of luring fish, comprising placing a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance in a body of water containing fish.